

JENDICK - Appln. No. 09/412,362

REMARKS

Claims 44-82, 90, 91, 93-96, and 98-112 are pending in the application. Dependent claims 105-112 are provided herein for added scope of protection.

Applicant appreciates the courtesies extended by Examiners Gerrity and Huynh during a personal interview with the undersigned conducted on June 17, 2003. The substance of the personal interview is discussed below.

Claims 44, 63, 98, and 99 are rejected under 35 U.S.C. §102(e) by Stasiuk, U.S. Patent No. 6,105,806 (the Stasiuk patent). This rejection is respectfully traversed.

During the interview, it was basically agreed that we have come to issue, which ultimately for resolution may require appeal, or other action described below, depending on the outcome of the next office action. The Examiner's position is that Stasiuk teaches laser engraving into the metal portion or surface, per claims 98, 100, 103. (It is noted that claims 44 and 63 do not require laser engraving into the metal.) Applicant's position is that Stasiuk teaches removal of the coating only, for the reasons outlined in the Amendment of May 28, 2002, the Supplemental Amendments of June 6, 2002 and July 8, 2002, and the Preliminary Amendment of March 14, 2003 (Stasiuk's most recent PCT application expressly teaches that the earlier Stasiuk U.S. patent does not engrave into the metal, but only removes the coating). The contents of these Amendments are incorporated herein by reference.

Another option which was discussed during the personal interview was to antedate Stasiuk with a 131 Affidavit. Applicant will seriously consider this option upon receipt of the next office action. Moreover, the Affidavit may be unnecessary if some of the rejections, e.g., Kōsba/Kwon, discussed below, are withdrawn. At the very least, the contents of the Affidavit will change depending on the conclusions reached in the next office action.

Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 44, 45, 56, 57, 61-64, 74-76, 81, 82, 90, 91, 93-96, 98, and 99 are rejected under 35 U.S.C. §103(a) over Kubacki et al., U.S. Patent No. 4,476,781, in view of Stasiuk. This rejection should be withdrawn for reasons discussed above, for example, Stasiuk does not teach laser engraving into the metal, per claims 98 and 100. Also, Applicant may consider filing a 131 Affidavit upon receiving the next office action. Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 46-49 and 65-67 are rejected under 35 U.S.C. §103(a) over Kubacki et al. in view of Stasiuk as applied to claims 44 and 63 above and further in view of Kwon, U.S. Patent No. 6,160,835. Applicant respectfully submit that there is no motivation, outside of the use of impermissible hindsight, to combine the teachings of Kwon with Kubacki et al. or

Stasiuk. Kwon is a hand-held device. Kwon is not used in an intermittent fashion, as claimed. It would be virtually impossible to use Kwon's hand-held device in the environment of Kubacki et al. or Stasiuk, with any degree of accuracy. Kwon has no relation to engraving of cans, can ends or tabs. The materials engraved in Kwon do not include those typically included in cans, can ends, or tabs. There is no teaching in Kwon that use of light in the near IR range would be useful for cans, can ends, or tabs.

Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 50-55 and 68-73 are rejected under 35 U.S.C. §103(a) over Kubacki et al in view of Stasiuk further in view of Kwon as applied to claims 46 and 65 above, and further in view of Kobsa, U.S. Patent No. 6,163,010. At the outset, it is unclear why one of ordinary skill in the art would modify Stasiuk to first include laser light in the near IR range, as allegedly taught in Kwon, a hand-held device, and then to further modify Stasiuk to include the mode selecting feature of Kobsa, a device for cutting through a metal strip having a thickness of 0.1 to 2.0 mm. Kwon and Kobsa are not related to the manufacture of cans, and nor are they related to intermittent engraving.

Kobsa is not even related to engraving. It is for cutting through an object. The objects have a thickness of between 0.1 and 2.0 mm. There is no motivation for combining the teachings of Kobsa with Kubacki et al., Stasiuk or Kwon.

Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 58-60 and 77-79 are rejected under 35 U.S.C. §103(a) over Kubacki et al in view of Stasiuk as applied to claims 44 and 76 above and further in view of JP 7-53099. Applicant traverses these rejections for reasons previously advanced in previous responses.

Claims 44, 45, 56-57, 61-64, 74-76, 81, 82, 89-96, and 98 are rejected under 35 U.S.C. §103(a) over Kubacki et al in view of Carlson, U.S. Patent No. 4,375,025. This rejection is respectfully traversed.

During the interview, the Examiners agreed to reconsider Applicant's arguments previously submitted. Applicant's representative was under the impression that Primary Examiner Gerrity believes this rejection is improper and would not hold up at the Board. In summary, Carlson deals with laser marking electronic components. The markings are made, and can only be made, when the components are being driven or moved. This is exactly opposite to what Applicant sets for in claim 44, for example, wherein the engraving is performed in an immobilized condition. Applicant's arguments filed on March 14, 2003 are incorporated herein by reference. This rejection is inappropriate.

During the interview, Examiner Huynh indicated that he feels that there is prior art (not of record) which shows the claimed features. However, Applicant agrees with Examiner Gerrity that Examiner Huynh should produce any such prior art in the next office action, as it is improper to reject the claims based on insufficient art, i.e., Kubacki et al./Carlson, in the hopes that Applicant will amend the claims and avoid the issue of whether other prior art, not of record, may be used to reject the current claims as they stand.

Additional features were also discussed during the interview. For example, dependent claims 101 and 102 recite that the strip is in the immobilized condition for less than about 60 milliseconds for forming at least four characters. Carlson does not teach intermittent engraving during an immobilized condition, since the marking occurs during movement. Nothing in Carlson could possibly suggest activating the laser in a 60 millisecond period of immobilization. Nothing in Carlson teaches providing four engraving marks in that period.

Dependent claims 61 and 81 describe that the articles are opening tabs to be attached to ends of cans. Carlson does not teach the use of a laser for engraving tabs to be attached to the ends of cans.

Reconsideration and withdrawal of the rejection are respectfully requested.

Claims 46 and 65 are rejected under 35 U.S.C. §103(a) over Kubacki et al in view of Carlson as applied to claims 44 and 63 above and further in view of Kwon. Claims 47-55 and 66-73 are rejected under 35 U.S.C. §103(a) over Kubacki et al in view of Carlson, further in view of Kwon as applied to claims 46 and 65 above and further in view of Kobsa. Claims 58-60 and 77-79 are rejected under 35 U.S.C. §103(a) over Kubacki et al in view of Carlson as applied to claims 44 and 76 above and further in view of JP 7-53099. These rejections are respectfully traversed.

Neither Kwon, Kobsa, nor JP 7-53099 make up for the deficiencies noted above with respect to Kubacki and Carlson. Therefore, these dependent claims are allowable by virtue of their dependence on claims 44 and 63, and for their recitation of additional patentable subject matter.

Also, claim 99 is objected to under 37 CFR 1.75(c). This rejection is respectfully traversed.

Claim 99 is a product by process claim and should not be rejected as being improper. Please see MPEP 2173.05(f), MPEP 2173.05(p), and MPEP 608.01(n)(III.). Withdrawal of this objection is respectfully requested. Moreover, even if this claim was restrictable, it would have to be rejoined if claim 44 is eventually found allowable. See MPEP 821.04.

Should the Examiner believe that anything further is desirable to place the application in better condition for allowance, he is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,
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